UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Application Number: 10/709,793

Filing Date: May 28, 2004

Appellant(s): ANDRA ET AL.

Peter Balnave

<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/10/2008 appealing from the Office action mailed 01/02/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The amendment after final on 02/28/2008 which was initially not entered into record by the examiner, contains an amendment to claims 2-6, 8-10, 12-16, 18-20, and 22-24 which is reflected on claims presented in this appeal brief filed on 06/10/2008. The examiner now enters the amendment to claims 2-6, 8-10, 12-16, 18-20, and 22-24 to reduce the issues of appeal, and this amendment should be entered into record. The statement of the status of claims in the brief is correct.

(4) Status of Amendments After Final

There are amendments after final (filed 02/28/2008) which were initially not entered into record by the examiner, but now are being entered into record to reduce the issues for appeal.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is substantially correct. An after-final amendment filed on 02/28/2008 to claims 2-6, 8-10, 12-16, 18-20, and 22-24 that was initially not entered into record, is now being entered by the examiner to reduce the issues for appeal. The amendment should be entered to claims 2-6, 8-10, 12-16, 18-20, and 22-24.

(8) Evidence Relied Upon

2002/0178103	Dan et al.	11/28/2002
2003/0167446	Thomas	09/04/2003
2002/0042657	Albazz et al.	04/11/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7.   Claims 1-6, 8-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dan et al.** (U.S. PGPUB 2002/0178103), in view of **Thomas**

(U.S. PGPUB 2003/0167446), and in view of **Albazz et al.** (U.S. PGPUB
2002/0042757).

8.   Regarding claims 1 and 11, **Dan** teaches a method and a program storage
device comprising:

A) establishing an original pre-defined data type definition format for an XML
transaction (Paragraphs 31, 50, & 58, Figures 8-9);

C) pre-building static structures of said XML transaction (Paragraphs 33-35);

E) classifying dynamic structures of said XML transaction with empty tags and
single occurrence classifiers for repeating dynamic structures (Paragraphs 34-
35);

I) wherein an occurrence of said runtime of said XML transaction occurs when
said XML transaction occurs when said XML transaction is sent to a trading
partner (Paragraphs 33-34, 36);

J) wherein said combining comprises filling the empty tags of said dynamic
structures (Paragraphs 34-35); and

K) constructing a final XML structure based on the combining process
(Paragraph 46);

L) wherein said final XML structure comprises fully built dynamic structures that
comprise completely filled tags (Paragraphs 34-35, 46).

        The examiner notes that **Dan** teaches **"establishing an original pre-
defined data type definition format for an XML transaction"** as "According to
the invention, a meta-contract governs or controls the negotiation process. The
meta contract is either pre-negotiated or formed from information provided by the
parties in one or more electronic documents, preferably in the form of profiles,
described in greater detail below... Before creating a meta-contract, the parties
must first accept a negotiation protocol to be used during the negotiation
process. After the parties accept the negotiation protocol, a meta-contract may
be formed and the parties may begin a negotiation" (Paragraph 31), "FIG. 8
illustrates the preferred data type definition (DTD) covering all offer documents"
(Paragraph 50), and "FIG. 9 illustrates the preferred data type definition (DTD)

covering all counter offer documents" (Paragraph 58). The examiner further notes that **Dan** teaches **"pre-building static structures of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that **Dan** teaches **"classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party" (Paragraph 35). The examiner further notes that **Dan** teaches **"wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). The examiner further notes that **Dan** teaches **"wherein said combining comprises filling the empty tags of said dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party" (Paragraph 35) The examiner further notes that **Dan** teaches **"constructing a final XML structure based on the combining process"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46). The examiner further notes that **Dan** teaches **"wherein said final XML**

structure comprises fully built dynamic structures that comprise completely filled tags" as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46).

       Dan does not explicitly teach:

B) creating a copy of said original pre-defined data type definition format for said XML transaction; and

M) wherein said final XML structure is validated by comparing said final XML structure against said copy of said original pre-defined data type definition format for said XML transaction.

       Thomas, however, teaches **"creating a copy of said original pre-defined data type definition format for said XML transaction"** as "the processor reads 12 the document type definition (DTD) of the first XML file and creates a copy 13 of the DTD" (Paragraph 38) and **"wherein said final XML structure is validated by comparing said final XML structure against said copy of said original pre-defined data type definition format for said XML transaction"** as "Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4" (Paragraph 44).

       It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

       Dan and **Thomas** do not explicitly teach:

D) wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type and a predetermined trading partner profile;

F) building a list of a sequence of said static and dynamic structures;

G) linking said list to the XML transaction and said predetermined trading partner profile;

H) combining said static structures with said dynamic structures at a runtime to construct said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction.

Albazz, however, teaches **"wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type and a predetermined trading partner profile"** as "the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55) and "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68), **"building a list of a sequence of said static and dynamic structures"** as "Product List Filter (PLF) is a representation of a seller's product list which replaces the complete list of all products available from a seller organization (as used herein the term "products" includes both products and services). This representation comprises products selection and/or exclusion criteria, based on a selection metaphor. The representation criteria are structured and stored in a

way that ensures rebuilding the targeted product list from a master product
catalog, or from multiple catalogs or other product information sources, any time
the target product list is required. Depending upon the used PLF, a generated list
could be static with the same products being produced at every run, or could be
dynamic with new products being added or removed according to changes taking
place at the seller organization. FIG. 5 illustrates an example of the creation and
storage of a Product List Filter" (Paragraph 76), **"linking said list to the XML
transaction and said predetermined trading partner profile"** as "PLFs can be
implemented within the contract preparation and negotiation cycles in different
scenarios. For example, a seller may define a product list to be offered to a
particular buyer and create a specific PLF for that list" (Paragraph 79), and "seller
can define one or more PLFs that can be linked to offered Ts&Cs Sets or
restricted to certain buyers, thus controlling the content of the product list on a
buyer-specific basis. The specified buyer(s) become a target buyer for the filtered
product list, and PLFs enforce the products viewable by any particular buyer in
the execution aspect of the invention, discussed below, whenever the buyer
accesses the seller's e-commerce site (store or marketplace). The buyer can
then select or search for required products from the filtered version of the seller's
master product list" (Paragraph 80), and **"combining said static structures
with said dynamic structures at a runtime to construct said XML
transaction based on said sequence, said type of XML transaction, said
trading partner profile, and said dynamic structures of said XML
transaction"** as "All contract Static Elements and Dynamic Elements are tied
together in a contract profile, which includes linking the Product List Filter(s) and
any Dynamic Elements in the Terms and Conditions Set. FIG. 6 illustrates an
example of linking a Ts&Cs Page having a multiple Folds to a multiple-tier PLF.
Other scenarios might involve linking Ts&Cs Page Folds to other contract
elements, for example to different divisions of a buyer organization" (Paragraph
81).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Albazz's** would have allowed **Dan's** and **Thomas's** to provide a method to increase the flexibility of contract negotiation through the removal of rigid pre-defined terms and subsequent replacement of dynamic best-fit terms, as noted by **Albazz** (Paragraph 12).

Regarding claims 2 and 12, **Dan** further teaches a method and program storage device comprising:
A) wherein said XML transaction occurs in a business-to-business (B2B) electronic environment (Paragraph 29).

The examiner notes that **Dan** teaches **"wherein said XML transaction occurs in a business-to-business (B2B) electronic environment"** as "method of automated negotiations of the invention is capable of producing a contract such as, for example, a service contract, and preferable a business-to-business (B-B) service contract" (Paragraph 29).

Regarding claims 3 and 13, **Dan** further teaches a method and program storage device comprising:
A) predefining said trading partner profile associated with a predetermined trading entity (Paragraph 38).

The examiner notes that **Dan** teaches **"predefining said trading partner profile associated with a predetermined trading entity"** as "when each of the parties has a preexisting profile, an initial version of a contract may be created by automatically combining information from the profiles, subject to a later negotiation process" (Paragraph 38).

Regarding claims 4 and 14, **Dan** further teaches a method and program storage device comprising:

A) wherein said pre-building of said static structures occurs prior to runtime of said XML transaction (Paragraphs 33-34).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures occurs prior to runtime of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that contract of **Dan's** runs once the negotiation phase begins to fill in the initial blank negotiable fields 1023 and 1024.

Regarding claims 5 and 15, **Dan** does not explicitly teach a method and program storage device comprising:

A) wherein the construction of said final XML structure follows definition established by said copy of said original pre-defined data type definition format for said XML transaction.

Thomas, however **teaches "wherein the construction of said final XML structure follows definition established by said copy of said original pre-defined data type definition format for said XML transaction"** as "The XML file is read and a temporary copy made and stored 28 in the RAM 7. The temporary copy of the contents of the XML file is displayed 29 by means of the output interface 10 so that a user is able to input modifications to the XML file via the input interface 9... Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4. Of course, the modified version of the XML file may be stored separately from the original version of the XML file instead of overwriting the original XML version" (Paragraphs 43-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

Regarding claims 6 and 16, **Dan** further teaches a method and program storage device comprising:

A) filling said empty tags of said dynamic structures with business data values (Paragraphs 34-35); and

B) building multiple repeating dynamic structures at runtime of said XML transaction (Paragraphs 34-35, 44).

The examiner notes that **Dan** teaches **"filling said empty tags of said dynamic structures with business data values"** as "a negotiable field 1023 or 1024 may be treated as a blank that may be completed by the negotiating party" (Paragraph 35) and **"building multiple repeating dynamic structures at runtime of said XML transaction"** as "A negotiation comprises one or more sub negotiations. Each sub negotiation involves a subset of all of the items to be negotiated" (Paragraph 44).

Regarding claims 8 and 18, **Dan** further teaches a method and program storage device comprising:

A) wherein said trading partner profile comprises partner data, communication protocol data, transaction data, transaction format data, and XML format version data (Paragraphs 33-35, Figure 4).

The examiner notes that **Dan** teaches **"wherein said trading partner profile comprises partner data, communication protocol data, transaction data, transaction format data, and XML format version data"** as "The profile may include information such as: products and services provided, specific

business processes that the service provider can perform, security requirements, and technology information such as which message-exchange protocols are supported by the service provider" (Paragraph 33) and "Allowable choices 1014 may cover, for example, business and/or technical considerations such as a list of supported transport protocols, a list of supported shipping and transport services (such as overnight shipping, airmail delivery, etc.), delivery times, and/or the optional use of preexisting meta contract" (Paragraph 35).

Regarding claims 9 and 19, **Dan** further teaches a method and program storage device comprising:
A) wherein said pre-building of said static structures and a pre-building of said dynamic structures occurs at a time of installation of said trading partner profile in a database in said computer system (Paragraph 10).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures and a pre-building of said dynamic structures occurs at a time of installation of said trading partner profile in a database in said computer system"** as "providing a starting state for a contract, wherein the starting state may be a previous contract, a publicly defined template such as, for example, Open Buying on the Internet (OBI), or a template defined prior to the negotiation by one of the parties" (Paragraph 10).

Regarding claims 10 and 20, **Dan** further teaches a method and program storage device comprising:
A) linking said static structures to a type of XML transaction and said predetermined trading partner profile (Paragraphs 32-34); and
B) storing the linked static structures in said database (Paragraph 37).

The examiner notes that **Dan** teaches **"linking said static structures to a type of XML transaction and said predetermined trading partner profile"** as "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32) and

"storing the linked static structures in said database" as "In a preferred embodiment of the invention, an initial version of a contract may be obtained from a repository that contains a collection of searchable information, including individual businesses' contract templates or profiles and other related information" (Paragraph 37).

Regarding claim 21, **Dan** teaches a computer system comprising:

A) means for establishing an original pre-defined data type definition format for an XML transaction (Paragraphs 31, 50, & 58, Figures 8-9);

C) means for pre-building static structures of said XML transaction (Paragraphs 33-35);

E) means for classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures (Paragraphs 34-35);

I) wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner (Paragraphs 33-34, 36);

J) wherein said combining comprises filling the empty tags of said dynamic structures (Paragraphs 34-35); and

K) means for constructing a final XML structure based on the combining process (Paragraph 46);

L) wherein said final XML structure comprises fully built dynamic structures that comprise completely filled tags (Paragraphs 34-35, 46).

The examiner notes that **Dan** teaches **"means for establishing an original pre-defined data type definition format for an XML transaction"** as "According to the invention, a meta-contract governs or controls the negotiation process. The meta contract is either pre-negotiated or formed from information provided by the parties in one or more electronic documents, preferably in the form of profiles, described in greater detail below... Before creating a meta-contract, the parties must first accept a negotiation protocol to be used during the

negotiation process. After the parties accept the negotiation protocol, a meta-contract may be formed and the parties may begin a negotiation" (Paragraph 31), "FIG. 8 illustrates the preferred data type definition (DTD) covering all offer documents" (Paragraph 50), and "FIG. 9 illustrates the preferred data type definition (DTD) covering all counter offer documents" (Paragraph 58). The examiner further notes that **Dan** teaches **"means for pre-building static structures of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that **Dan** teaches **"means for classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party" (Paragraph 35). The examiner further notes that **Dan** teaches **"wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). The examiner further notes that **Dan** teaches **"wherein said combining comprises filling the empty tags of said dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party"

(Paragraph 35) The examiner further notes that **Dan** teaches **"means for constructing a final XML structure based on the combining process"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46). The examiner further notes that **Dan** teaches **"wherein said final XML structure comprises fully built dynamic structures that comprise completely filled tags"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46).

        Dan does not explicitly teach:

B) means for creating a copy of said original pre-defined data type definition format for said XML transaction; and

M) wherein said final XML structure is validated by comparing said final XML structure against said copy of said original pre-defined data type definition format for said XML transaction.

        Thomas, however, teaches **"means for creating a copy of said original pre-defined data type definition format for said XML transaction"** as "the processor reads 12 the document type definition (DTD) of the first XML file and creates a copy 13 of the DTD" (Paragraph 38) and **"wherein said final XML structure is validated by comparing said final XML structure against said copy of said original pre-defined data type definition format for said XML transaction"** as "Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4" (Paragraph 44).

        It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

     Dan and **Thomas** do not explicitly teach:

D) wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type and a predetermined trading partner profile;

F) means for building a list of a sequence of said static and dynamic structures;

G) means for linking said list to the type of XML transaction and said predetermined trading partner profile;

H) means for combining said static structures with said dynamic structures at a runtime of said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction.

     Albazz, however, teaches **"wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type and a predetermined trading profile"** as "the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55) and "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68), **"means for building a list of a sequence of said static and dynamic structures"** as "Product List Filter (PLF) is a representation of a seller's product

list which replaces the complete list of all products available from a seller organization (as used herein the term "products" includes both products and services). This representation comprises products selection and/or exclusion criteria, based on a selection metaphor. The representation criteria are structured and stored in a way that ensures rebuilding the targeted product list from a master product catalog, or from multiple catalogs or other product information sources, any time the target product list is required. Depending upon the used PLF, a generated list could be static with the same products being produced at every run, or could be dynamic with new products being added or removed according to changes taking place at the seller organization. FIG. 5 illustrates an example of the creation and storage of a Product List Filter" (Paragraph 76), **"means for linking said list to the type of XML transaction and said predetermined trading partner profile"** as "PLFs can be implemented within the contract preparation and negotiation cycles in different scenarios. For example, a seller may define a product list to be offered to a particular buyer and create a specific PLF for that list" (Paragraph 79), and "seller can define one or more PLFs that can be linked to offered Ts&Cs Sets or restricted to certain buyers, thus controlling the content of the product list on a buyer-specific basis. The specified buyer(s) become a target buyer for the filtered product list, and PLFs enforce the products viewable by any particular buyer in the execution aspect of the invention, discussed below, whenever the buyer accesses the seller's e-commerce site (store or marketplace). The buyer can then select or search for required products from the filtered version of the seller's master product list" (Paragraph 80), and **"means for combining said static structures with said dynamic structures at a runtime of said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction"** as "All contract Static Elements and Dynamic Elements are tied together in a contract profile, which includes linking the Product List Filter(s) and any Dynamic Elements in the Terms and Conditions Set. FIG. 6 illustrates an example of linking a Ts&Cs Page having

a multiple Folds to a multiple-tier PLF. Other scenarios might involve linking Ts&Cs Page Folds to other contract elements, for example to different divisions of a buyer organization" (Paragraph 81).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Albazz's** would have allowed **Dan's** and **Thomas's** to provide a method to increase the flexibility of contract negotiation through the removal of rigid pre-defined terms and subsequent replacement of dynamic best-fit terms, as noted by **Albazz** (Paragraph 12).

Regarding claim 22, **Dan** teaches a computer system comprising:

A) means for predefining said trading partner profile associated with a predetermined trading entity (Paragraph 38);

B) means for filling said empty tags of said dynamic structures with business data values(Paragraphs 34-35); and

C) building multiple repeating dynamic structures at runtime of said XML transaction (Paragraphs 34-35, 44);

D) means for linking said static structures to a type of XML transaction and said predetermined trading partner profile (Paragraphs 5, and 32-34); and

E) means for storing the linked static structures (Paragraph 37).

The examiner notes that **Dan** teaches **"means for predefining said trading partner profile associated with a predetermined trading entity"** as "when each of the parties has a preexisting profile, an initial version of a contract may be created by automatically combining information from the profiles, subject to a later negotiation process" (Paragraph 38), **"means for filling said empty tags of said dynamic structures with business data values"** as "a negotiable field 1023 or 1024 may be treated as a blank that may be completed by the negotiating party" (Paragraph 35), **"building multiple repeating dynamic structures at runtime of said XML transaction"** as "A negotiation comprises one or more sub negotiations. Each sub negotiation involves a subset of all of

the items to be negotiated" (Paragraph 44), **"means for constructing a final XML structure using said means for combining"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46), **"means for linking said static structures to a type of XML transaction and said predetermined trading partner profile"** as "The general information about the TPA provides the TPA name, its type and its version. The roles and the participants section specifies the various roles and participants along with the contact information of the business partners, and it also includes the valid duration of the contract, the number of times the contract may be used and how often it may be invoked" (Paragraph 5) and "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32), and **"means for storing the linked static structures"** as "In a preferred embodiment of the invention, an initial version of a contract may be obtained from a repository that contains a collection of searchable information, including individual businesses' contract templates or profiles and other related information" (Paragraph 37).

Regarding claim 23, **Dan** further teaches a computer system comprising:
A) wherein said static structures are pre-built prior to runtime of said XML transaction (Paragraphs 33-34).

The examiner notes that **Dan** teaches **"wherein said static structures are pre-built prior to runtime of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that contract of **Dan's** runs once the negotiation phase begins to fill in the initial blank negotiable fields 1023 and 1024.

Regarding claim 24, **Dan** further teaches a computer system comprising:
A) wherein said pre-building of said static structures and said dynamic structures are pre-built at a time of installation of said trading partner profile in a database of said computer system (Paragraph 10).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures and said dynamic structures are pre-built at a time of installation of said trading partner profile in a database of said computer system"** as "providing a starting state for a contract, wherein the starting state may be a previous contract, a publicly defined template such as, for example, Open Buying on the Internet (OBI), or a template defined prior to the negotiation by one of the parties" (Paragraph 10).

(10) Response to Argument

A.   Claims 1-6, 8-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dan et al.** (U.S. PGPUB 2002/0178103), in view of **Thomas** (U.S. PGPUB 2003/0167446), and in view of **Albazz et al.** (U.S. PGPUB 2002/0042757).

**Arguments (1):**   Regarding Independent Claims 1, 11, and 21, Appellant argues that "The present invention defines a "static structure" as "a pre-built XML structure with pre-filled values based on associated transaction type and TPP [Trading Partner Profile]", (Specification, paragraph [0024], lines 13-15). Therefore, the pre-built XML "static structures" of the present invention are static, i.e., unchanging, and pre-filled with values based on the associated transaction type and trading partner profile. Hence, there are no negotiable fields in the static structures with pre-filled values of the present invention because the structures are static and pre-filled. In contrast, the contract template of Dan contains one or more negotiable fields 1023, 1024 that will be filled with future negotiations".

However, the examiner wishes to states that **Dan** is merely used to teach the limitation "pre-building static structures of said XML transaction" in the

independent claims, and that the secondary art of **Albazz** is used to teach the limitation "wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type". Moreover, the examiner wishes to refer to paragraphs 33 and 34 of **Dan** which state "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that **Dan** clearly teaches the claimed "pre-building static structures of said XML transactions" because the "almost-contract electronic contract document" template of **Dan** has elements that are already complete (static elements).

Furthermore, the limitation of "wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type" is considered as non-functional descriptive material. Specifically, the phrase "based on a transaction type" is deemed as non-functional descriptive material, and as a result, has no patentable weight.

__Arguments (2):__   Regarding Independent Claims 1, 11, and 21, Appellant argues that "However, the DTD of the present invention is originally fixed and its DTD copied, and does not require slight modifications or amending of element type declarations as does Thomas because the final XML structure of the present invention comprises pre-filled static structures, to which no modifications or amendments of the DTD are made, and dynamic structures that comprise empty tags, to which no modifications or amendments of the DTD are made, so that the final or constructed XML structure may be compared to or validated against the original pre-defined data type definition".

However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "[The DTD] does not require slight modifications or

amending of element type declarations") are not recited in the rejected claim(s).
Although the claims are interpreted in light of the specification, limitations from
the specification are not read into the claims. See *In re Van Geuns*, 988
F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

    Arguments (3):   Regarding Independent Claims 1, 11, and 21,
Appellant argues that "Albazz merely discloses generating a list that could be
static with the same products being produced at every run, or could be dynamic
with new products being added or removed according to changes taking place at
the seller organization. In contrast, the present invention describes the feature of
"building a list of a sequence of said static and dynamic structures", wherein both
static and dynamic structures are previously defined, i.e., "pre-building static
structures of said XML transaction, wherein said static structures comprise a pre-
built XML data structure with pre-filled values based on a transaction type of said
XML transaction and a predetermined trading partner profile; classifying dynamic
structures of said XML transaction with empty tags and single occurrence
classifiers for repeating dynamic structures"."".

    However, the cited art of **Dan** is used to teach "pre-building static
structures of said XML transaction" and "classifying dynamic structures of said
XML transaction with empty tags and single occurrence classifiers for repeating
dynamic structures". Moreover, the independent claim merely recites the
limitation as "building a list of a sequence of said static and dynamic structures".
Furthermore, the examiner wishes to refer to Paragraph 76 of **Albazz** which
states that "Product List Filter (PLF) is a representation of a seller's product list
which replaces the complete list of all products available from a seller
organization (as used herein the term "products" includes both products and
services). This representation comprises products selection and/or exclusion
criteria, based on a selection metaphor. The representation criteria are structured
and stored in a way that ensures rebuilding the targeted product list from a
master product catalog, or from multiple catalogs or other product information
sources, any time the target product list is required. Depending upon the used

PLF, a generated list could be static with the same products being produced at every run, or could be dynamic with new products being added or removed according to changes taking place at the seller organization. FIG. 5 illustrates an example of the creation and storage of a Product List Filter" (Paragraph 76). The examiner further wishes to state that by adding new products to a static list ("new products being added"), **Albazz's** list is both static (containing the previous list) and dynamic (the added products), rather than either static or dynamic.

In addition, Appellant argues that "The static and dynamic product lists of Albazz do not disclose, teach or suggest the present invention's features of "wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type of said XML transaction and a predetermined trading partner profile" or "dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures".

However, the cited art of **Dan** is used to teach the limitation of "dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures". Furthermore, the examiner wishes to refer to Paragraphs 55, 68, and 79-80 of **Albazz** which state that "the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55), "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved

and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68), "PLFs can be implemented within the contract preparation and negotiation cycles in different scenarios. For example, a seller may define a product list to be offered to a particular buyer and create a specific PLF for that list" (Paragraph 79), and "seller can define one or more PLFs that can be linked to offered Ts&Cs Sets or restricted to certain buyers, thus controlling the content of the product list on a buyer-specific basis. The specified buyer(s) become a target buyer for the filtered product list, and PLFs enforce the products viewable by any particular buyer in the execution aspect of the invention, discussed below, whenever the buyer accesses the seller's e-commerce site (store or marketplace). The buyer can then select or search for required products from the filtered version of the seller's master product list" (Paragraph 80). The examiner further wishes to state that **Albazz** clearly teaches an XML data structure (Ts&C Set) with pre-filled values (selecting amongst different pre-determined Ts&Cs Sets) that can be differentiating with respect to different profiles ("seller can define one or more PLFs that can be linked to offered Ts&Cs Sets or restricted to certain buyers, thus controlling the content of the product list on a buyer-specific basis. The specified buyer(s) become a target buyer for the filtered product list").

In addition, Appellant argues that "The static and dynamic product lists of Albazz are not explicitly defined as XML data structures corresponding to a transaction. A list is not a transaction. Therefore, Applicants respectfully submit that Albazz does not disclose, teach or suggest the present invention's feature of "pre-building static structures of said XML transaction, wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type of said XML transaction and a predetermined trading partner profile; classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures; building a list of a sequence of said static and dynamic structures", as recited in independent claims 1, 11, and 21".

However, the cited art of **Dan** is used to teach "pre-building static structures of said XML transaction" and "classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures". Moreover, the independent claim merely recites the limitation as "building a list of a sequence of said static and dynamic structures". Moreover, the examiner wishes to refer to Paragraphs 55, 79, and 80-81 of **Albazz** which state that the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55), "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68), "PLFs can be implemented within the contract preparation and negotiation cycles in different scenarios. For example, a seller may define a product list to be offered to a particular buyer and create a specific PLF for that list" (Paragraph 79), and "A seller can define one or more PLFs that can be linked to offered Ts&Cs Sets or restricted to certain buyers, thus controlling the content of the product list on a buyer-specific basis. The specified buyer(s) become a target buyer for the filtered product list, and PLFs enforce the products viewable by any particular buyer in the execution aspect of the invention, discussed below, whenever the buyer accesses the seller's e-commerce site (store or marketplace). The buyer can then select or

search for required products from the filtered version of the seller's master product list. All contract Static Elements and Dynamic Elements are tied together in a contract profile, which includes linking the Product List Filter(s) and any Dynamic Elements in the Terms and Conditions Set. FIG. 6 illustrates an example of linking a Ts&Cs Page having a multiple Folds to a multiple-tier PLF. Other scenarios might involve linking Ts&Cs Page Folds to other contract elements, for example to different divisions of a buyer organization" (Paragraphs 80-81). The examiner further wishes to state that the product lists of **Albazz** clearly linked to the Ts&C Sets with represent the transaction.

Arguments (4):   Regarding Independent Claims 1, 11, and 21, Appellant argues that "Applicants respectfully submit that Albazz does not cure the deficiencies of Dan and Thomas, because Albazz also does not disclose, teach or suggest the present invention's feature of "pre-building static structures of said XML transaction, wherein said static structures comprise a pre-built XML data structure with pre-filled values based on a transaction type of said XML transaction and a predetermined trading partner profile". Instead, merely discloses generating a list that could be static with the same products being produced at every run, or could be dynamic with new products being added or removed according to changes taking place at the seller organization. ".

However, the cited art of **Dan** is used to teach the limitation of "pre-building static structures of said XML transaction". Furthermore, the examiner wishes to refer to Paragraph 76 of **Albazz** which states that "Product List Filter (PLF) is a representation of a seller's product list which replaces the complete list of all products available from a seller organization (as used herein the term "products" includes both products and services). This representation comprises products selection and/or exclusion criteria, based on a selection metaphor. The representation criteria are structured and stored in a way that ensures rebuilding the targeted product list from a master product catalog, or from multiple catalogs or other product information sources, any time the target product list is required. Depending upon the used PLF, a generated list could be static with the same

products being produced at every run, or could be dynamic with new products being added or removed according to changes taking place at the seller organization. FIG. 5 illustrates an example of the creation and storage of a Product List Filter" (Paragraph 76). The examiner further wishes to state that by adding new products to a static list ("new products being added"), **Albazz's** list is both static (containing the previous list) and dynamic (the added products), rather than either static or dynamic.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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